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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,085	02/06/2004	James F. Macier	1058742	2084
27062 7590 06/15/2007 OSLER, HOSKIN & HARCOURT LLP (BRP2) 2100 -1000 DE LA GAUCHETIERE ST. WEST MONTREAL, H3B4W5 CANADA			EXAMINER VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	
			MAIL DATE	DELIVERY MODE
			06/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/708,085	MACIER ET AL.	
	Examiner	Art Unit	
	Ajay Vasudeva	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/21/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-33 and 41-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-33 and 41-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18, 19, 22-29, 41-47, 49-51 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrera (US 6,358,106 B1).

Herrera shows an outboard motor (fig. 5) having an engine [8], an engine cover [14], and first and second lower/midsection covers [22, 24]. At least three silencers [44] are disposed in the volume defined between the engine and the covers so as to substantially match the contour of the respective cover (fig. 5 and fig. 6; col. 3-4).

The first and third silencers attached to the lower covers have a density that is greater than the density of the second silencer attached to the upper cover. As such, the first and third silencers are considered to be more waterproof than the second silencer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 21, 30-33, 48, 52, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrera (US 6,358,106 B1).

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Herrera shows an outboard motor with a 250 hp engine, as above, with the lower silencers having a density of two pounds per cubic foot, and the upper silencer having a density of one pound per cubic foot (col. 4, lines 41-53). However, Herrera does not specifically disclose the lower silencers having a density of approximately twenty-two pounds per cubic foot, and the upper silencer having a density of at least four pound per cubic foot (claims 20, 21, 30-33, 48, 52, 54).

Further, Herrera does not show the motor emitting a certain decibel at a specific rpm (claims 30-33).

The Examiner notes that for higher capacity engines emitting louder noise, the claimed density selection for the respective silencers is considered to be an obvious design choice. It would have been obvious for an artisan to make the silencers with substantially higher density, such as with a density in the range of approximately twenty-two pounds per cubic foot. Choosing such density would have been desirable because it would have provided maximum noise reduction without adding too much weight to the outboard motor or without adversely affecting the engine performance.

Regarding the level of noise produced by the motor at a specific rpm, it is noted that such is a function of diverse factors – such as the age and maintenance condition of the engine, the gear/transmission ratio, the load on the engine, the fuel and lubricant used, the condition of the air intake and exhaust systems, the atmospheric temperature condition at the time of engine startup or running etc. Therefore, it would have been inherent for the engine to emit a noise corresponding to the specific rpm, as being claimed, for a certain combination of such diverse factors.

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Response to Arguments

5. Applicant's arguments filed 3/21/2007 with respect to the rejections based on Herrera ('106) have been fully considered but they are not persuasive.

Applicant's arguments regarding claim 18: Applicant has argued that the vibro-acoustic treatment of Herrera is a "thin sheet" that adheres to the inner surfaces of the motor covers of Herrera, and as such does not occupy a significant portion of the volume between the lower motor cover of Herrera and the midsection "of the propulsion unit" of Herrera. Therefore, the vibro-acoustic treatment of Herrera does not fill a majority of the volume between the midsection and the midsection cover.

Response A: The silencer of Herrera is a composite material comprising a sheet of moldable acoustic barrier material 44, a layer of pressure-sensitive adhesive material 48, an acoustical grade open-cell flexible foam core 50, and a film 52 fused to the foam core. The composite material can have a thickness of greater than 0.5 inches (col. 4, lines 40-50). Therefore, the composite material is not considered to be a "thin sheet" as characterized by the Applicant, but rather considered as a thick padding.

Further, however, it is noted that the claims merely recites "a volume between a midsection and a midsection cover" without specifically defining the boundaries of the recited "midsection". In the present case, a "midsection" can broadly be interpreted as a space that is enclosed by the exposed surface of film 52 that faces away from the cover 46 (see fig. 6). In other words, the exposed surface of the film 52 defines an outer periphery, or contour, of the "midsection".

With such broad interpretation, Applicant may note that the silencer is considered as filling the entire volume – not just a majority volume – between the midsection and the

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midsection cover. Similarly, the silencer has a shape that is same as – not just substantially matching – the shape of the volume.

Applicant's arguments regarding claim 41: In addition to the "thin sheet" argument, Applicant has also argued that the vibro-acoustic treatment of Herrera does not have a shape that substantially matches the shape of the volume between the lower motor cover and the midsection of the propulsion unit.

Response B: It is first noted that claim 41 does not recite a volume between the lower motor cover and the midsection (emphasis added), but rather sets forth a volume between a cover and an engine. Therefore, the claim does not require the silencer to have a shape that substantially matches the shape of the "volume between the lower motor cover and the midsection of the propulsion unit", as being argued.

Further, in accordance with the dictionary meaning, the term "shape" has been interpreted to mean "an external surface, contour or outline of a specific form or figure".

In the case of Herrera, the shape – or the outer contour -- of the volume enclosed between the cover and the engine is defined by the inner surface of the cover. Similarly, the shape of the silencer that is adhered on the inner surface of the cover is also defined by the inner surface of the cover. Therefore, the shape of the silencer is considered to be the exact same of – and not just substantially matching -- the shape of the volume between the cover and the engine.

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Applicant's arguments regarding claim 49: Applicant has argued that the vibro-acoustic treatment of Herrera does not have a shape that substantially matches the shape of the volume between the lower motor cover and the midsection of the propulsion unit.

Response C: As noted above, the term "shape" has been interpreted to mean "an external surface, contour or outline of a specific form or figure".

In the case of Herrera, the shape – or the outermost surface -- of the volume between the lower motor cover and the midsection of the propulsion unit is defined by the inner surface of the lower motor cover. Similarly, the shape of the silencer that is adhered on the inner surface of the lower motor cover is also defined by the inner surface of the lower motor cover. Therefore, the shape of the silencer is considered to be exactly same as – and not just substantially matching -- the shape of the volume between the lower motor cover and the midsection of the propulsion unit.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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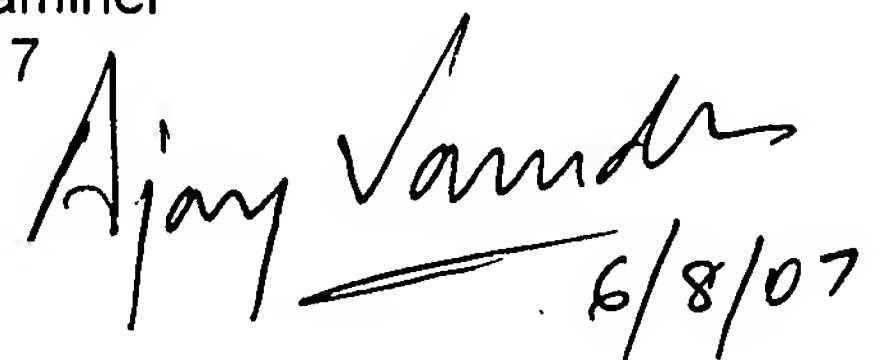
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva
Primary Examiner
Art Unit 3617



6/8/07